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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,193	07/28/2000	Glenn J. Orloff	A0000001-04-CWA	3154

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

9/821250

## Office Action Summary

Application No.

09/626,193

Applicant(s)

ORLOFF ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-115 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a hair removal device with a plurality of blades with a radius of curvature not greater than about 1000 angstroms, classified in class 30, subclass 32.
  - II. Claims 64-69, 85-87, 91, and 92, drawn to a hair removal device with at least 10 micro-blades connected to the substrate, classified in class 30, subclass 50.
  - III. Claims 33-38, drawn to a hair removal device wherein the blades comprise a cutting depth of not greater than about 1000 microns, classified in class 30, subclass 346.
  - IV. Claims 8-13, 23-25, 30-31, and 70-75, drawn to a hair removal device with comprising at least 10 blades and said blades comprise a radii of curvature not greater than about 1000 angstroms, classified in class 30, subclass 32.
  - V. Claims 39-44, 55-57, 61, 63, and 76-81, drawn to a hair removal device comprising at least 10 blades and having a cutting depth of not greater than about 1000 microns, classified in class 30, subclass 346.5.
  - VI. Claims 14-19 and 45-51, drawn to a hair removal device wherein the blade comprise a cutting depth of not greater than about 1000 microns

and said blades comprise a radii of curvature not greater than about 1000 angstroms, classified in class 30, subclass 32.

- VII. Claims 26-29, drawn to a hair removal device having at least one guard element and radii of curvature not greater than about 1000 angstroms, classified in class 30, subclass 77.
- VIII. Claim 32, drawn to a hair removal device having a flexible substrate and radii of curvature not greater than about 1000 angstroms, classified in class 30, subclass 346.5.
- IX. Claims 58-60, drawn to a hair removal device having at least one guard element and blades with a cutting depth of not greater than about 1000 microns, classified in class 30, subclass 77.
- X. Claim 62, drawn to a hair removal device having a flexible substrate and blades with a cutting depth of not greater than about 1000 microns, classified in class 30, subclass 346.5.
- XI. Claims 88-90, drawn to a hair removal device having at least one guard element and at least 10 micro-blades, classified in class 30, subclass 77.
- XII. Claim 93, drawn to a hair removal device having a flexible substrate and at least 10 micro-blades, classified in class 30, subclass 346.5.
- XIII. Claims 94-95, drawn to a hair removal device with at least about 100 micro abrasive elements connected to the substrate, classified in class 451.

IVX. Claims 96-115, drawn to a method of making a personal hair removal device, classified in class 76.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, II, III, VII, VIII, IX, X, XI and XII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, the plurality of blades with a radius of curvature not greater than about 1000 angstroms of invention I has separate utility such as it could be used without the specific number of blades or cutting depth as in Groups II and III; conversely, the specific number of blades and/or cutting depth of inventions II and III has separate utility such as it could be used without the plurality of blades with a radius of curvature not greater than about 100 angstroms. See MPEP § 806.05(d).
3. Inventions of Group IV and I and III are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05 (C) , example 3. Group III is evidence that the combination of Group IV does not rely on the radius of curvature of Group I for patentability, and conversely, Group I is evidence that the combination of Group IV does not rely on the specific number of blades of Group III.
4. Inventions of Group V and II and III are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05

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(C) , example 3. Group III is evidence that the combination of Group V does not rely on the cutting blade depth of Group II for patentability, and conversely, Group II is evidence that the combination of Group V does not rely on the specific number of blades of Group III.

5. Inventions of Group VI and I and II are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05 (C) , example 3. Group I is evidence that the combination of Group VI does not rely on the cutting blade depth of Group II for patentability, and conversely, Group II is evidence that the combination of Group VI does not rely on the radius of curvature of Group I.

6. Inventions of Groups I-XII and XIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). For example, the combination as claimed does not require the particulars of the subcombination as claimed because the inventions of Groups I-XII do not require the particulars of the abrasive elements of Group XIII. The subcombination has separate utility such as it could be used without the particulars of Groups I-XII, for example, the specific number of blades.

7. Inventions of Groups IVX and I-XIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product

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or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another materially different process, for example, without the step of etching the blade supports.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A - the embodiment shown in Figures 1 and 2;
- Species B - the embodiment shown in Figures 3 and 4;
- Species C - the embodiment shown in Figures 5 and 6;
- Species D - the embodiment shown in Figures 9 and 10;
- Species E - the embodiment shown in Figures 11 and 12;
- Species F - the embodiment shown in Figures 13 and 14;
- Species G - the embodiment shown in Figures 15 and 16;
- Species H - the embodiment shown in Figures 17 and 18;
- Species I - the embodiment shown in Figures 19 and 20;
- Species J - the embodiment shown in Figures 3 and 4;

- Species K - the embodiment as claimed in claims 20, 52, 82 (straight blade);
- Species L - the embodiment as claimed in claims 21, 53, 83 (serrated blade);
- Species M - the embodiment as claimed in claims 22, 54, 84 (curved blade).

Applicant must further elect between the following species:

- Species AA - the embodiment shown in Figures 21 and 22;
- Species BB - the embodiment shown in Figures 23 and 24;
- Species CC - the embodiment shown in Figures 25 and 26;
- Species DD - the embodiment shown in Figures 35 and 36;
- Species EE - the embodiment shown in Figures 37 and 38.

If the applicant elects Group XIII above, then the applicant must further elect between the following species:

- Species AAA - the embodiment shown in Figure 39;
- Species BBB - the embodiment shown in Figure 40;
- Species CCC - the embodiment shown in Figure 41;
- Species DDD - the embodiment shown in Figure 42;
- Species EEE - the embodiment shown in Figures 7 and 8.

If the applicant elects Group IVX above, then the applicant must further elect between the following species:



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- Species AAAA - the embodiment as claimed in claim 101 (flexible substrate);
- Species BBBB - the embodiment as claimed in claim 102 (polyimide);
- Species CCCC - the embodiment as claimed in claim 103 (PEEK);
- Species DDDD - the embodiment as claimed in claim 107 (CVD);
- Species EEEE - the embodiment as claimed in claim 108 (PACVD);
- Species FFFF - the embodiment as claimed in claim 109 (ECD);
- Species GGGG - the embodiment as claimed in claim 110 (Sputter);
- Species HHHH - the embodiment as claimed in claim 111 (RFAD);
- Species IIII - the embodiment as claimed in claim 112 (sputtering);
- Species JJJJ - the embodiment as claimed in claim 113 (RIE);
- Species KKKK - the embodiment as claimed in claim 114 (ion milling);
- Species LLLL - the embodiment as claimed in claim 115 (Chemical etching).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

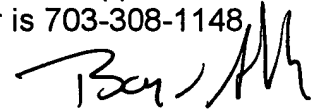
11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday thru Thursday between

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7:30am and 6:00pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.



**Boyer D. Ashley**  
**Primary Examiner**  
**Art Unit 3724**

bda  
April 22, 2002